



**UNITED STATES DEPARTMENT OF COMMERCE**  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/447,226

11/22/99

HENKIN

J

6356.US.P3

023492

HM12/0327

EXAMINER

ABBOTT LABORATORIES

DEPT. 377 - AP6D-2

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ABBOTT PARK IL 60064-6050

MOEZIE, F

ART UNIT

PAPER NUMBER

1653

5

DATE MAILED:

03/27/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/447,226

Applicant(s)

Henkin

Examiner

F. T. Moezie

Group Art Unit

1653

☒ Responsive to communication(s) filed on Nov 22, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire ONE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-17 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-17 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

☒ Notice to Comply (2 pages)

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

FH

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### DETAILED ACTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, drawn to a myriad of peptides and a pharmaceutical composition made therefrom, classified in class 530, subclass 327, for example.
  - II. Claim 15, drawn to a method of treating a patient in need of anti-angiogenesis therapy, classified in class 514, subclass depending on the disease being treated.
  - III. Claim 16, drawn to a composition for the treatment of a disease selected from:  
1) cancer, 2) arthritis, 3) psoriasis, 4) angiogenesis of the eye associated with infection or surgical intervention, 5) macular degeneration and 6) diabetic retinopathy, classified in class 514, subclass depending on the disease condition being treated.
  - IV. Claim 17, drawn to a method of isolating a receptor from a cell, classified in class 435, subclass 7.1, for example.
1. The inventions are distinct, each from the other because of the following reasons:
- Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process of using the product as claimed can be practiced with another materially

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different product such as the use of any one of the products in claims 12 and 13 and the product as claimed can be used in various methods of use such as the uses recited in claim 16.

Inventions I, II or III and IV are distinct one from the other. Inventions are distinct because they are not disclosed as capable of use together and they have different objectives, different modes of operation, different functions, and different effects. Moreover, the computer and the library searches are not coextensive. Additionally, the consideration of patentability is not the same for all of the inventions. Therefore, it would be an undue burden to examine all of the inventions in one application.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

#### **ELECTION OF SPECIES**

This application contains claims directed to the following patentably distinct species of the claimed invention:

Compounds 1-530 of claim 12 cited at pages 209 to 225 of the specification and,  
Compounds 1-64 of claim 13 cited at pages 225 to 227 of the specification.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species and indicate claim(s) readable thereon (**having a common core**) within the elected invention for prosecution

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on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and *a listing of all claims readable thereon*, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

*Applicant is advised that the reply to this requirement to be complete must include: a) an election of the invention, b) an election of the species and c) an election of the ULTIMATE specie (regardless of the invention elected) to be examined even though the*

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*requirement be traversed (37 CFR 1.143).* Applicant must further indicate claims reading on the elected species within the claims of the elected invention.

*An ULTIMATE specie of a compound is a compound wherein all of its variable parameters are fully accounted for including a showing of a chemical structure for the same.*

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

***NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS  
CONTAINING AMINO ACID SEQUENCE DISCLOSURES - attached herein.***

*A shortened statutory period for response to this part of the communication is set to expire one month from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to F.T. Moezie whose telephone number is (703) 305-4508.

*F.T. Moezie*